REMARKS

General

Claims 1-42 are pending in the application. Claims 1-42 stand rejected.

No amendment is made, and no new matter is added, by this response.

Citation of references

U.S. Patent Application Publication No. 2002/0082979 A1 (Sands et al.), cited as prior art against claims 13 and 28, appears to be a newly cited reference, but is not listed in the Form PTO-892 Notice of References Cited annexed to the Office action. In order to ensure a complete record, the Examiner is respectfully requested to issue a PTO-892 making the Sands reference of record in this application.

Rejections under 35 USC § 103

Claims 1-4, 10-12, 15-22, 27, 30-33, 36, and 39, of which claims 1 and 22 are independent, stand rejected as allegedly obvious over U.S. Patent Application No. 2002/0161684 (Whitworth) in view of U.S. Patent No. 5,806,048 (Kiron). The rejection is traversed.

Claims 1 and 22 recite, among other features, aggregating a plurality of securities of a single issuer into a bundled instrument security. There is no disclosure or suggestion of that feature in the cited references. The Examiner cites to paragraph [0070] of Whitworth as allegedly describing "a plurality of securities issued by a single issuer." That is incorrect. The whole of paragraphs [0066] to [0071] of Whitworth is a description of "method 300 ... using existing shares of a [sic] multiple companies." There is no disclosure or suggestion anywhere in Whitworth of aggregating a plurality of securities issued by a single issuer. Where there is a single issuer, an individual share is stripped into a dividend strip and a non-dividend share, without aggregation. Aggregation is described only when stripping a security that is already aggregated, such as an index stock or a unit trust or mutual fund unit, and those are always multiple-issuer aggregations.

Kiron is cited only as explicitly describing the use of a computer for the aggregation, and does not remedy the deficiency of Whitworth. In fact, Kiron's system is directed to generating a "fund of funds" simulating an aggregate of every available mutual fund that meets Kiron's quality standards, for example, being above a certain size (see col. 4, lines 41-43 and 58-59). If

any actual securities are purchased (col. 6, lines 47-50), which is not clear, they must represent a very large number of issuers.

Thus, the cited references do not teach or fairly suggest all the features of the claimed combination, and the claimed system and method are believed to be non-obvious over the references.

Claims 2-4, 10-12, 15-21, 27, 30-33, 36, and 39 depend from claims 1 and 22 and, without prejudice to their individual merits, are deemed to be non-obvious over the cited references for at least the same reasons as their respective base claims.

Regarding claim 3, the Examiner asserts that the abstract of Kiron describes bundling rules, and argues that it would have been obvious to use such rules "to ensure that only the securities which will maximize the returns will be selected." However, no bundling rules can be identified in Kiron's abstract, and the proposed motivation to combine is contrary to the teaching of Kiron. Kiron is trying to synthesize a "fund of funds" and so must emulate as accurately as possible the holdings of the subject funds, so he has no freedom to select particular securities.

Regarding claim 4, no reference to a trustee is found in the cited paragraph [0079] of Whitworth.

Regarding claim 10, Whitworth nowhere suggests, and the Examiner does not even allege that Whitworth suggests, aggregating disparate securities of a single issuer into one bundle, as claimed. The stated ground of rejection "using the same rationale as claim 2" is improper and does not constitute a valid rejection, since claims 2 and 10 are different.

Regarding claims 12 and 33, Whitworth and Kiron nowhere suggest, and the Examiner does not even allege that Whitworth or Kiron suggests, aggregating a selected multiple of the securities of a single issuer in one bundle, as claimed. The stated ground of rejection inconsistently "using the same rationale as" claim 2 against claim 12 and claim 3 against claim 33 is improper, since claims 2 and 3 are different from each other and from claims 12 and 33, and does not constitute a valid rejection.

Regarding claim 15, the cited paragraph [0075] of Whitworth does not teach or suggest an aggregation multiple based on specified factors, as claimed. Whitworth describes only using capitalization as a criterion for deciding which stock to strip.

Regarding claim 18, the cited claim 15 of Whitworth does not mention redemption of a security. Claim 15 is directed to calculation of the interest payable on the dividend strip.

Regarding claims 20 and 21, the cited passage at col. 4, lines 28-31 of Kiron is part of a long list of statistics relating to the underlying funds, and does not mention fees for creating or redeeming a bundled instrument security. The Examiner is respectfully referred to col. 3, lines 26-27 of Kiron, which states that "investors can buy and sell the securitized funds as often as they wish with no penalty."

Regarding claim 27, the cited col. 6, lines 3-8 of Kiron does not discuss the price charged to investors, as claimed. That passage describes only methods of weighting the securities within an index.

For at least these reasons also, at least claims 3, 4, 10, 12, 15, 18, 20, 21, 27, and 33 are believed to be non-obvious over the cited references.

Claims 5-9, 23-26, and 34-35 are rejected as allegedly obvious over Whitworth in view of Kiron and further in view of published US Patent Application No. 2004/0002910 (Mizukami). Claims 5-9, 23-26, and 34-35 depend from claims 1 and 22, and Mizukami is relied on only for additional features of the dependent claims. Without prejudice to their individual merits, claims 5-9, 23-26, and 34-35 are deemed to be non-obvious over the combination of three cited references for at least the same reasons as their respective base claims are non-obvious over Whitworth and Kiron alone.

In addition, regarding claims 6 and 7, no mention of the claimed depositary receipts is found in the cited paragraph [0095] of Mizukami.

Regarding claim 8, the rejection "using the same rationale as claim 7" does not state any valid ground of rejection, because the stated rejection of claim 7 is specific to the language of claim 7.

Regarding claim 9, the cited col. 2, line 64 to col. 3, line 9 of Kiron does not disclose or suggest that the securities are of the same type, as claimed. Kiron describes a "fund of funds" in which his security emulates a multiplicity of existing mutual funds, each of which invests in a multiplicity of real securities.

The rejections of claims 24, 25, and 26 are facially erroneous because they refer to rationales based on a different combination of cited references. In addition, the rejection of claim 25 is self-contradictory, because it refers to claim 10, and claims 10 and 25 recite mutually exclusive features.

The rejections of claims 34 and 35, as far as they can be understood, are traversed using the same rationale as claims 6 and 7.

Claims 13 and 28 are rejected as allegedly obvious over Whitworth in view of Kiron and further in view of published US Patent Application No. 2002/0082979 (Sands et al). Claims 13 and 28 depend from claims 1 and 22, and Sands is relied on only for additional features of the dependent claims. Without prejudice to their individual merits, claims 13 and 28 are deemed to be non-obvious over the combination of three cited references for at least the same reasons as their respective base claims are non-obvious over Whitworth and Kiron alone.

Claims 14 and 29 are rejected as allegedly obvious over Whitworth in view of Kiron and further in view of published US Patent Application No. 2001/0037277 (Willis et al). Claims 14 and 29 depend from claims 1 and 22, and Sands is relied on only for additional features of the dependent claims. Without prejudice to their individual merits, claims 14 and 29 are deemed to be non-obvious over the combination of three cited references for at least the same reasons as their respective base claims are non-obvious over Whitworth and Kiron alone. In addition, the cited paragraph [0006] of Willis describes tracking "capital events" including splits and mergers for the purpose of calculating a correct cost basis for the final security, but does not teach or suggest altering an aggregation multiple in a bundled instrument security in response to a split, merger, or other "capital event," as claimed.

Claims 37 and 38, which are independent, are rejected as obvious over Kiron in view of Whitworth. The rejection is traversed.

As regards claim 37, Kiron does not disclose or suggest the claimed "second means for bundling a plurality of single issuer, uniform typed units of the at least one publicly traded security into a tradable bundled instrument security in accordance with the bundling criteria while permitting other of the uniform typed units of the at least one publicly traded security to remain publicly traded." The cited passage at col. 8, lines 50-51 of Kiron mentions only "providing a database of information on securities available for trading," and does not support the rejection. Further, as explained above, Kiron does not teach or suggest bundling of "single issuer" securities, as claimed. Kiron also does not disclose or suggest the claimed "third means

for selling the bundled instrument security to at least one investor at a price that is a predetermined multiple of at least one unit of the at least one security." The cited col. 6, lines 3-8 of Kiron does not discuss the price charged to investors, as claimed. That passage describes only methods of weighting the securities within an index. As discussed above, Whitworth does not remedy those deficiencies.

Whitworth does not disclose "fourth means for redeeming the bundled instrument security from at least one investor," as claimed. The cited claim 15 of Whitworth is directed to calculation of the interest payable on the dividend strip. The Examiner acknowledges that Kiron does not remedy the deficiency.

Thus, the cited references fail to teach or suggest several features of claim 37, and claim 37 would not have been obvious to a person of ordinary skill in the art over the cited references.

Claim 38 is rejected "using the same rationale as claim 37" and is deemed to be non-obvious for at least the same reasons as claim 37. In addition, to the extent that claim 38 is different from claim 37, claim 38 is deemed to be allowable because no valid ground of rejection is outstanding on the record.

Claim 40 is rejected as allegedly obvious over Whitworth and Kiron and further in view of US Patent Application No. 2002/0087373 (Dickstein et al.) and U.S. Patent Application No. 2002/0046154 (Pritchard). Claim 40 depends from claim 38, and Dickstein and Pritchard are relied on only for additional features of the dependent claim. Without prejudice to its individual merits, claim 40 is deemed to be non-obvious over the combination of four cited references for at least the same reasons as base claim 38 is non-obvious over Whitworth and Kiron alone.

Claims 41 and 42 are rejected as allegedly obvious over Whitworth, Kiron, and Dickstein. Claims 41 and 42 depend from claim 38, and Dickstein is relied on only for additional features of the dependent claims. Without prejudice to their individual merits, claims 41 and 42 are deemed to be non-obvious over the combination of three cited references for at least the same reasons as base claim 38 is non-obvious over Whitworth and Kiron alone.

For all of the above reasons, the rejections of claims 1-42 are without merit as applied to the claims now presented, and should be withdrawn.

CONCLUSION

For all of the foregoing reasons, the application is in condition for allowance. Withdrawal of all rejections and an early notice of allowance of claims 1-42 are respectfully requested.

Respectfully submitted,

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